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In re Application of
SAUNDERS, Ian
U.S. Application No.: 10/510,082
PCT No.: PCT/NL03/00247
Int. Filing Date: 02 April 2003
Priority Date: 02 April 2002
Attorney Docket No.: 060327-5002
For: STAGE DEVICE FOR A VACUUM
CHAMBER

DECISION ON PETITION
UNDER 37 CFR 1.47(b)

This decision is in response to applicant's "Request for Reconsideration and Renewed Petition under 37 CFR 1.47(b)" filed 24 July 2006 to accept the application without the signature of the sole inventor, Ian Saunders. The \$200 petition fee has been submitted.

BACKGROUND

On 02 April 2003, applicant filed international application PCT/NL03/00247 which claimed a priority date of 02 April 2002. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 09 October 2003. Pursuant to 37 CFR 1.495, the thirty-month period for paying the basic national fee in the United States expired at midnight on 02 October 2004.

On 01 October 2004, applicant filed a transmittal letter for entry into the national stage in the United States, which accompanied by, *inter alia*: the requisite basic national fee as required by 35 U.S.C. 371(c)(1) and a copy of the international application.

On 07 March 2005, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) must be filed. The notification set a two-month time limit in which to respond.

On 11 May 2005, applicant filed a petition under 37 CFR 1.47(b). In a decision dated 19 December 2005, applicant's petition was dismissed without prejudice.

On 24 July 2006, applicant filed "Request for Reconsideration and Renewed Petition under 37 CFR 1.47(b)."

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the requisite petition fee under 37 CFR 1.17; (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the nonsigning inventor; (4) an oath or declaration executed by the 37 CFR 1.47(b) applicant on behalf of and as agent for the nonsigning inventor; (5) proof of proprietary interest in the application; and, (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damages. The 37 CFR 1.47(b) applicant has satisfied the requirements of items (1) and (6). However, items (2); (3); (5) and (6) have not been satisfied.

As to item (2), petitioner states that Ian Saunders cannot be found or reached after diligent effort. Section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.), **Proof of Unavailability or Refusal**, states, in part:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein.

Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included statement of facts. It is important that the statement contain facts as opposed to conclusions.

A review of the present petition reveals that petitioner has not provided an acceptable showing that a diligent effort was made to locate the nonsigning inventor, Ian Saunders. Petitioner states that a copy of the application papers were mailed to Ian Saunders on 04 May 2005 and 13 July 2006. However, it appears that these papers were mailed to Mr. Saunders' corporate address, which appears to be the same address as the 37 CFR 1.47(b) applicant. Therefore, the 04 May 2005 and 13 July 2006 mailings cannot be considered as documentary evidence that the nonsigning inventor could not be found or reached. Further, petitioner states he attempted to contact Ian Saunders via electronic mail. A copy of the electronic mail has been provided. However, petitioner fails to include evidence to demonstrate that the materials were actually received by the nonsigning inventor. Lastly, petitioner should provide verification that the email address (saunders@tpd.tno.nl) belongs to the nonsigning inventor.

Regarding item (3) above, a clear statement of the last known address of the non-signing inventor has not been provided. In situations where an inventor does not execute the oath or declaration, the inventor's address should be the last known address at which the inventor customarily receives mail. (See MPEP §605.03) Ordinarily, the last known address will be the last known residence of the nonsigning inventor, not the address of the 37 CFR 1.47 applicant. (See MPEP §409.03(e))

Regarding Item (4), petitioner has submitted a declaration which included an unsigned signature block for the nonsigning inventor, Ian Saunders. However, the declaration submitted is not in compliance with 37 CFR 1.497(a)(3) which requires that the oath or declaration identify each inventor and the country of citizenship of the inventor. In this case, the declaration does not identify the citizenship of the inventor (Ian Saunders). Additionally, the citizenship of the inventor is not included on the "Added Page to Combined Declaration and Power of Attorney . . ." Since the declaration does not clearly identify the citizenship of the inventor, it is considered defective under 37 CFR 1.497(a)(3) and 37 CFR 1.63(c)(1).

Concerning Item (5), section 409.03(f) of the M.P.E.P., **Proof of Proprietary Interest**, states, in part:

When an application is deposited pursuant to 37 CFR 1.47(b), the 37 CFR 1.47(b) applicant must prove that, as of the date the application is deposited in the Patent and Trademark Office, (1) the invention has been assigned to the applicant, or (2) the inventor has agreed in writing to assign the invention to the applicant, or (3) the applicant otherwise has sufficient proprietary interest in the subject matter to justify the filing of the application.

If the application assigned, a copy of the assignment (in the English Language) must be submitted. The assignment must clearly indicate that the invention described in the 37 CFR 1.47(b) application was assigned to the 37 CFR 1.47(b) applicant prior to the date the application is deposited in the Patent and Trademark Office. A statement under 37 CFR 3.73(b) by the assignee must also be submitted (see MPEP § 324) . . .

When an inventor has agreed in writing to assign an invention described in an application deposited pursuant to 37 CFR 1.47(b), a copy of that agreement should be submitted. If an agreement to assign is dependent on certain specified conditions being met, it must be established by affidavit or declaration that those conditions have been met. A typical agreement to assign is an employment agreement where an employee (nonsigning inventor) agrees to assign to his or her employer (37 CFR 1.47(b) applicant) all inventions made during employment. When such an agreement is relied on, it must be established by the affidavit or declaration of a person having firsthand knowledge of the facts that the invention was made by the employee while employed by the 37 CFR 1.47(b) applicant.

If the invention has not been assigned, or if there is no written agreement to assign, the 37 CFR 1.47(b) applicant must demonstrate that he or she otherwise has a sufficient proprietary interest in the matter.

A proprietary interest obtained otherwise than by assignment or agreement to assign may be demonstrated by an appropriate legal memorandum to the effect that a court of competent jurisdiction (federal, state, or foreign) would by the weight of authority in that jurisdiction award title of the invention to the 37 CFR 1.47(b) applicant. The facts in support of any conclusion that a court would award title to the 37 CFR 1.47(b) applicant should be made of record by way of an affidavit or declaration of the person having firsthand knowledge of same. The legal memorandum should be prepared and signed by an attorney at law familiar with the law of the jurisdiction involved. A copy (in the English language) of a statute (if other than the United States statute) or a court decision (if other than a reported decision of a federal court or a decision reported in the United States Patents Quarterly) relied on to demonstrate a proprietary interest should be made of record.

Regarding item (5), petitioner has not demonstrated that applicant has a property interest in the invention. Petitioner has provided a letter from Alexander Ferguson, Dutch and European patent attorney, which states that Mapper Lithography IP B.V. has proprietary interest in the application. However, Alexander Ferguson fails to provide documentary evidence that the 37 CFR 1.47(b) applicant has a property interest in the invention, i.e., assignment; employment agreement; or legal memorandum. As stated above, when an application is deposited pursuant to 37 CFR 1.47(b), the 37 CFR 1.47(b) applicant must prove that, as of the date the application is deposited in the Patent and Trademark Office, (1) the invention has been assigned to the applicant, or (2) the inventor has agreed in writing to assign the invention to the applicant, or (3) the applicant otherwise has sufficient proprietary interest in the subject matter to justify the filing of the application. The legal memorandum should be prepared and signed by an attorney at law familiar with the law of the jurisdiction involved. A copy (in the English language) of a statute (if other than the United States statute) or a court decision (if other than a reported decision of a federal court or a decision reported in the United States Patents Quarterly) relied on to demonstrate a proprietary interest should be made of record.

For the reasons stated above, it would not be appropriate to accept the application without the signature of Ian Saunders under 37 CFR 1.47(b) at this time.

CONCLUSION

The petition under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to: Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

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